

REMARKS

Applicants thank the Examiner for the telephonic interview held January 8, 2010 and the helpful comments provided. Presently, Claims 1-4 and 6-11 are pending. By this paper, Applicants amend Claims 1-4 and 6-11 and have added new Claims 53-61. Support for amended Claims 1-4 and 6-11, as well as, new Claims 53-61 can be found throughout the specification and in the claims originally filed with the application, including, for example, Examples 1 and 9 and page 3 lines 17-22 of the specification, and original Claim 18. Accordingly, Claims 1-4 and 6-11, as well as new Claims 53-55 are presented for consideration and further examination in view of the following amendments and remarks.

Objections to the Specification

The Examiner has objected to the specification arguing that Applicants have attempted to incorporate subject matter into the application by reference to GenBank accession numbers. Applicants have amended the claims to remove reference to the GenBank accession numbers and refer to the Sequestosome 1 gene by its name, which is well established in the field. Accordingly, Applicants request that the objection be withdrawn.

Claim Objections

The Examiner objected to Claims 1-4 and 6-11 for lacking a clear nexus between “a first isolated population of cells” and “a second isolated population of cells” as recited in Claim 1 and the “said first population” and “said second population” as recited in Claims 1, 8, 9, and 10. Applicants have amended Claims 1, 8, 9, and 10 to recite “said first isolated population” and “said second isolated population” as suggested by the Examiner. Applicants respectfully request that the objection be withdrawn.

Claim Rejections under 35 U.S.C. § 112

Enablement

The Examiner rejected Claims 1-4 and 6-11 under 35 U.S.C. § 112 for failing to comply with the enablement requirement as the “claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to . . . make and/or use the

invention.” Particularly, the Examiner rejected the claims on the grounds that “the specification fails to provide essential subject matter for the practice of the claimed invention.” In accordance with the Examiner’s suggestion, Applicants have amended the claims to remove specific reference to the GenBank accession numbers and to refer to Sequestosome 1 and the other referenced genes by names that are well known in the field.

The Examiner further rejected Claims 1-4 and 6-11 for lack of enablement for failing to demonstrate that a “decreased expression” of the Sequestosome 1 gene has been identified, “making it unpredictable to make a tobacco product with decreased expression of SQSTM 1.” Applicants have amended the Claims in accordance with the Examiner’s suggestions to recite a method of selecting a tobacco. Applicants’ new claims recite methods of identifying a tobacco that produces Sequestosome I expression. Working examples describing this identification method are provided (e.g. Example 9, Table 11).

The Examiner additionally rejected Claims 1-4 and 6-11 for lack of enablement on the grounds that the claims directed to assays on any cells were too broad. To expedite prosecution, Applicants have amended the claims to require human cells. Accordingly, Applicants respectfully request that the Examiner withdraw the rejections for lack of enablement.

Written Description

The Examiner also rejected Claims 1-4 and 6-11 for failing to comply with the written description requirement under 35 U.S.C. § 112. The Examiner has argued that Claims 1-4 and 7-11 encompass an enormous number of nucleotide molecules but that amendment of the claims to reflect a specific species and specific gene name may allow for the rejection to be withdrawn. Applicants have amended the claims in accordance with the Examiner’s suggestion to refer to human cells relative to the Sequestosome 1 gene, as is known in the field.

The Examiner additionally rejected Claims 1-4 and 6-11 under 35 U.S.C. § 112 for failure to “particularly point out and distinctly claim the subject matter which the applicant regards as the invention.” Particularly, the Examiner asserts that Claims 1-4 and 6-11 are indefinite for lacking a “positive active step relating back to the preamble”, for the confusion arising from reciting “acid NM 003900 Sequestosome 1”, and for lack of antecedent basis for “said whole smoke” as recited in Claim 10. Applicants have amended the claims in accordance

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with the Examiner's suggestions to indicate that the claims are drawn to "selecting a tobacco." Applicants' new claims recite identifying a tobacco that produces Sequestosome I expression. Additionally, Applicants have amended the claims to refer to the genes by the names that are well known in the field, and Applicants have amended Claim 10 to recite "said smoke" which finds antecedent basis in Claim 1. Applicants respectfully request that the rejections for lack of written description be withdrawn.

No Disclaimers or Disavowals

Although the present communication may include alterations to the application or claims, or characterizations of claim scope or referenced art, Applicants are not conceding in this application that previously pending claims are not patentable over the cited references. Rather, any alterations or characterizations are being made to facilitate expeditious prosecution of this application. Applicants reserve the right to pursue at a later date any previously pending or other broader or narrower claims that capture any subject matter supported by the present disclosure, including subject matter found to be specifically disclaimed herein or by any prior prosecution. Accordingly, reviewers of this or any parent, child or related prosecution history shall not reasonably infer that Applicant has made any disclaimers or disavowals of any subject matter supported by the present application.

Applicants have made a good faith effort to respond to all of the objections and rejections raised by the Examiner and submit that the amended claims and new claims are in condition for allowance. If, however, any unresolved issues remain, Applicants invite the Examiner to call the undersigned at his direct number 619-687-8643 to resolve any issues promptly.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

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Respectfully submitted,

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